

converting data, it would have been obvious to one of ordinary skill in the art at the time of the invention to perform all of these functions on an independent site since it has been held that constructing a formally integral structure in various elements involves only routine skill in the art – citing to *Nerwin v. Erlichman*, 168 USPQ 177, 179.

The Office Action further rejected claims 1-34 under 35 U.S.C. § 103 as being unpatentable over "the disclosure of the applicant." Specifically, the Office Action set forth that the applicant discloses a known method comprising: 1) Merchants that build mini storefronts on other's websites; 2) The converting of data into compatible formats back and forth; 3) Charging; and 4) Keeping track of transaction data. The Office Action then sets forth that the "meat" of the current invention is the automation of a known process. Thus, the Office Action concludes that, since merely providing an automatic means to replace a manual activity is not sufficient to distinguish over the prior art, the claims are unpatentable – citing to *In re Venner*, 262 F.2d 91, 95 (CCPA 1958).

In response, the applicants submit that these rejections of claims 1-34 fail to set forth a prima facie case of obviousness and, as such, the rejections must be withdrawn. It is well settled that a prima facie case of obviousness requires, among other things, that all of the claim limitations be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art. Distilling the invention down to the "gist" or "thrust" of the invention disregards the requirement of analyzing the subject matter "as a whole."

Turning to the Office Action, it is respectfully submitted that the Office Action has failed to demonstrate that each and every element set forth in the claims can be found in a prior art reference or combination of prior art references. Instead of addressing each and every claim

limitation, the Office Action only addresses the claim language in a general manner. Therefore, since it is evident that the Office Action has impermissibly distilled the invention down to its "gist" (e.g., its "meat") and has not considered the claim language as a whole (i.e., each and every word), the rejections must be withdrawn.

By way of specific example, it is submitted that the Office Actions fails to set forth where, among other things, Fields discloses the recited "at least one translator on the clearinghouse site for converting data compliant with the merchant database format into data compliant with the partner database format" or the "converting on the clearinghouse site with the at least one translator the first set of data [being compliant with the merchant database format] into a second set of data compliant with the partner database format." Rather than disclose a system that translates and converts data so as to be compliant with a particular database format, Fields discloses no more than a system for parsing an HTML Web page source where extracted elements are plugged into another HTML Web page template so that the HTML Web page appears to have originated with a hosting site. Similarly, the Office Action has not demonstrated where the subject patent application discloses that each and every element recited in the claims is "well known." Rather, the Office Action summarily states that "the applicant discloses a known method" without providing any evidence in support of said statement. Therefore, for the reason that the Office Action fails to demonstrate where the prior art discloses each and every element of every one of the claimed inventions as is required to maintain a prima facie case of obviousness, the rejections must be withdrawn.

It is further respectfully submitted that the Office Action has impermissibly relied upon legal precedent to provide the rationale supporting obviousness. Legal precedent can provide the rational supporting obviousness only if the facts in the case are sufficiently similar to those in the

application. It is submitted that the Office Action has not established that the facts in the relied upon cases are similar to those in the subject application and, therefore, the rejection must be withdrawn. Further, the applicants respectfully submit that it is not appropriate to rely solely on case law as the rationale supporting obviousness since the elements of the claimed "clearinghouse site" are critical limitations that must be considered in their entirety. *See* MPEP 2144. For example, as described in the subject application, the "clearinghouse site" is critical since it solves the problems associated with the prior art. These claimed solutions cannot be said to be disclosed, taught, or suggested by the cited art.

#### CONCLUSION

The subject application is considered to be in condition for allowance. Such action on the part of the Examiner is respectfully requested. If, however, the Examiner feels that a telephone conference would expedite the allowance of the subject application, the Examiner is requested to contact the attorney undersigned. While it is not believed that any fees are due, the Commissioner is authorized to charge any fee deficiencies to deposit account number 011,156.

Respectfully submitted,

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**Certificate of Mailing:** I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, DC 20231 on this 4 day of October, 2002.

By: 

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